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09/667,612 09/22/00 GUYAN

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EXAMINER

TM02/0718

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ART UNIT

PAPER NUMBER

2164

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07/18/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.

09/667,612

Applicant(s)

GUYAN, G. Victor et al

Examiner

Jim Calve

Art Unit

2164

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Sep 22, 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-42 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 20) ☐ Other:

Art Unit: 2164

## **DETAILED ACTION**

### ***Claim Objections***

1. Claim 1 is objected to because of the following informalities:
  - a. There appears to be a typographical error in line 1 of claim 1: "A method for evaluation line item data ...". Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-42 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- a. Several limitations lack antecedent basis. Examples include:
  - i. Claim 1, lines 5-6: "the selected line item".
  - ii. Claims 6, 20, and 34, line 2: "the deduction".
  - iii. Claim 15, line 6: "the selected line item".
  - iv. Claim 29, lines 6-7: "the selected line item".

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

Art Unit: 2164

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-9, 11-23, 25-37, and 39-42 are rejected under 35 U.S.C. 102(b) as being anticipated by Borghesi et al, U.S. patent 5,950,169.

Borghesi et al disclose a method, system, and medium for evaluating line item data, including displaying at least one line item (e.g., Figures 6, 7, 9-12; column 2, line 50 et seq; column 3, line 5 et seq; column 6, line 15 et seq; column 7, line 40 et seq; column 8, line 50 et seq; column 19, line 6 et seq), selection of at least one line item from a claim handler (e.g., Figures 6, 7, 8E, 8G, 9-12; column 7, line 54 et seq; column 9, line 8 et seq; column 11, line 65 et seq; column 12, line 37 et seq; column 14, line 35 et seq; column 17, line 30 et seq; column 19, line 6 et seq; column 19, line 35 et seq), and receiving payment execution authorization (e.g., column 15, line 1 et seq), by direct payment (e.g., column 16, line 50 et seq), vendor transfer (e.g., total loss determination) (e.g., Figure 21; column 10, line 5 et seq; column 17, line 15 et seq; column 18, line 41 et seq; column 19, line 47 et seq), preauthorized payment (e.g., Figure 16; column 15, line 64 et seq; column 16, line 43 et seq), processor and memory (e.g., 26, 36) (Figure 2).

Borghesi et al also disclose receiving a direct payment amount (e.g., check) (e.g., column 16, line 50 et seq; column 18, line 52 et seq), back office communication (e.g., inherently disclosed), authorizing vendor transfer of authorized vendor database (e.g., Figures 8A-8L; column 10, line 57 et seq), upgrade availability, as broadly recited (e.g., column 10, line 5 et seq; column 14, line 23 et seq; column 18, line 33 et seq), deduction verification (e.g., column 18, line 1 et seq) line item payment authorization of receiving selection of at least one line item and

Art Unit: 2164

form of payment, and authorizing a transaction (e.g., column 18, line 7 et seq), receiving check payment and account information (inherently disclosed) (e.g., column 16, line 50 et seq; column 18, line 52 et seq), threshold amount (e.g., Figure 7; column 10, line 5 et seq; column 10, line 29 et seq), and date range (e.g., particular accident causing damage).

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 10, 24, and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Borghesi et al, U.S. patent 5,950,169, in view of DiRienzo et al, U.S. patent 6,076,066.

Borghesi et al disclose a method, system, and medium for evaluating line item data, as discussed, including payment means. Borghesi et al do not disclose electronic fund transfer. To the extent that such modification would not have been obvious to one of ordinary skill in the art at the time of the invention (e.g., to expedite settlement), DiRienzo et al disclose a method, system, and medium for evaluating line item data, including payment by check and electronic funds transfer (e.g., column 22, line 12 et seq). Electronic funds transfer provides a well-known equivalent means of settling claims (e.g., column 22, line 16 et seq). It would have been obvious to one of ordinary skill in the art at the time of the invention to provide for claim adjudication and

Art Unit: 2164

settlement via electronic funds transfer, in addition to payment by check, as taught by DiRienzo et al, on the method, system, and medium of Borghesi et al to facilitate claim settlement.

*Conclusion*

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. Huffman, U.S. patent 5,870,711.
- b. Chen et al, U.S. patent 5,504,674.
- c. Wong, U.S. patent 5,432,904.
- d. Carbone et al, U.S. patent 5,128,859.
- e. Montagna et al, U.S. patent 4,899,292.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jim Calve, whose telephone number is (703) 308-1884. The examiner can be reached on Monday through Friday from 6:45 am to 6:45 pm. If the examiner is unavailable, the examiner's supervisor, Vincent Millin, may be reached at 703-308-1065. The fax number of the organization is 703-308-9051/9052. Any inquiry of a general nature should be directed to the receptionist at 703-305-3900.

JPC  
JPC

July 10, 2001

  
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